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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/690,852

10/21/2003

Christopher Stevens

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EXAMINER

LEIVA, FRANK M

ART UNIT

PAPER NUMBER

3717

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/690,852	<b>Applicant(s)</b> STEVENS ET AL.	
	<b>Examiner</b> FRANK M. LEIVA	<b>Art Unit</b> 3717	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,7,9-15,18,20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,7,9-15,18,20 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 16 September 2010 has been entered.

### ***Acknowledgements***

2. The examiner acknowledges claims 1, 9, 11, 12, 20 and 21 amended in applicant's submission filed 16 September 2010.

### ***Response to Arguments***

3. Applicant's arguments filed 16 September 2010 have been fully considered but they are not persuasive for the following reasons;

4. Regarding the argument on page 6 of applicant's remarks directed to the rejection of claims 1 and 12; "Applicants respectfully submit that Seelig does not disclose guaranteeing any win, let alone guaranteeing a successful first outcome in a bonus feature." Seelig figure 9 is very explicit in generating a bonus award (168) after qualifying for a bonus round. After the first award has been given (guaranteed) the player can opt to gamble it (170) or keep it (182); Thus the first prize has been guaranteed.

5. Regarding the argument on page 6 of applicant's remarks directed to the rejection of claims 1 and 12; "Furthermore, Seelig does not disclose any outcome that is a function of a subsequent prize, not to mention any outcome that is a function of a subsequent prize." Language is not in scope of the claim. The word function is not used in the claims

and to say that an outcome is based on said probability does not make it a function of the subsequent prize, It simply states that because there is a next game, the outcome has to be generated; that is based on the fact that the player has opted to continue the bonus game and thus a probability of loosing the winnings has been brought to bear, the system has to now generate the next outcome for the player, All covered under Seelig.

6. Regarding the argument directed to claims 2-4, 7, 9, 10, 11 13-15, 18, 20 and 21 dependency on claims 1 and 12, as applied above the argument is not persuasive.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 1-4, 7, 9-10, 12-15, 18 and 20 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Seelig et al. (US 2002/0107066 A1).**

9. **Regarding claims 1 and 12; Seelig** discloses a gaming machine comprising a display displaying a number of won credits, (fig. 1); and a game controller controlling images of symbols to be displayed on the display, (¶ [0045]); effecting on the display a bonus feature wherein at least a first outcome is guaranteed to be a successful

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outcome, (fig. 5); offering through the display a choice to select between continuing the bonus feature and ending the bonus feature, (fig. 9 #170) and, if the choice selected is continuing the bonus feature, determining (1) a subsequent prize for a successful subsequent outcome, (fig. 9 #172); and (2) a probability of the successful subsequent outcome based on the subsequent prize for the successful subsequent outcome; and generating a subsequent outcome based on said probability, (fig. 9 #170), if the subsequent outcome is a successful outcome, offering through the display the choice of continuing with the bonus feature, (fig. 9 #180) but if the subsequent outcome is an unsuccessful outcome, ending the bonus feature, (fig. 9 #186), and forfeiting at most a portion of the credits accumulated, (fig. 9 #186).

**10. Regarding claims 2 and 13;** Seelig discloses wherein the game controller affects the bonus feature when a predetermined trigger condition occurs in a base game, (fig. 3 and 5).

**11. Regarding claims 3, 4, 14 and 15;** Seelig discloses wherein the display displays a pay table that indicates a number of credits that will be paid for various successful outcomes which occur during the playing of the bonus feature, and wherein the display includes a prize meter which provides a cumulative total of credits won due to successful outcomes which have occurred during the playing of the bonus feature (fig. 1), belly glass pay table and bonus meter 52 and 53 and total prize meter 54.

**12. Regarding claim 10;** Seelig discloses further comprising a selector receiving an input choice between continuing and ending the bonus feature, (¶ [0038]).

**13. Regarding claims 7 and 18;** Seelig discloses wherein the choice is continuing the bonus feature; the game controller determines the prize for a successful subsequent outcome using a weighted random selection, (claim 15).

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**14. Regarding claims 9 and 20**, according to admitted prior art that all games of chance have and inherent probability and calculation of that probability is not dependent of an equation but on the rules of the game. Calculation of the probabilities involved in the game does not carry patentable weight.

Regarding the examiner's assertion of Official Notice; the examiner deems the Official Notice asserted in the previous action as admitted prior art since there was no contest or traverse raised in applicant's response to the action. Please see MPEP 2144.03.

**15. Regarding claims 11 and 21**, Seelig discloses if the subsequent outcome is an unsuccessful outcome forfeiting credits, (fig. 9 #186).

#### ***Examiner's Note***

**16.** The referenced citations made in the rejection(s) above are intended to exemplify areas in the prior art document(s) in which the examiner believed are the most relevant to the claimed subject matter. However, it is incumbent upon the applicant to analyze the prior art document(s) in its/their entirety since other areas of the document(s) may be relied upon at a later time to substantiate examiner's rationale of record. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). However, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed .... "In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK M. LEIVA whose telephone number is (571) 272-2460. The examiner can normally be reached on M-F 11:00 am - 4:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Melba Bumgarner can be reached on (571) 272-4709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melba Bumgarner/

Supervisory Patent Examiner, Art Unit 3717

/F. M. L. /

Examiner, Art Unit 3717